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EXAMINER				
VINIL LAM				
ART UNIT		PAPER NUMBER		
1792				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTOMail@traskbritt.com

# Office Action Summary

**Application No.**

10/620,002

**Applicant(s)**

CHOPRA ET AL.

**Examiner**

LAN VINH

**Art Unit**

1792

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

1. Applicant's arguments filed 11/5/2008 have been fully considered but they are not persuasive.

The applicants argue that the formulation of a slurry, as recited in claim 1, even when defined in terms of the results that may be achieved by use of the slurry, is a physical property of that slurry, not a functional limitation, and cannot be disregarded. This argument is unpersuasive because it is noted that claim 1 drawn to a composition and section 2112.01 of the MPEP states: "II. COMPOSITION CLAIMS -IF THE COMPOSITION IS PHYSICALLY THE SAME, IT MUST HAVE THE SAME PROPERTIES "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)". In this case, since Hudson teaches the identical slurry/chemical structure as the claimed slurry/composition, the properties applicant discloses and/or claims are necessarily present

It is argued that even assuming, for the sake of argument, that the recitation by independent claim 1 of a slurry that will substantially concurrently polish copper and tungsten is a functional limitation, M.P.E.P. § 2173.05(g) clearly requires the Office to evaluate and consider functional limitations, "just like any other limitation of [a] claim, for what [they] fairly [convey] to a person of ordinary skill in the pertinent art in the context

in which it is used. rate as or at a slower rate than copper is removed" is considered as intended use of the claimed composition/function of the claimed composition. In response, it is noted that claim 1 drawn to a composition and composition claim covers what the composition is not what the composition does and "Likewise the intended use of composition is not patentably significant. In re Albertson 141 USPQ 730 (CCPA 1964); In re Heck 114 USPQ 161 (CCPA 1957)". "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily.

The applicants argue that Hudson does not expressly describe a single slurry that is formulated to remove both copper and tungsten, Hudson also lacks any express description of a slurry that removes tungsten at substantially the same rate or at a slower rate than copper is removed, as required by amended independent claim 1 and Hudson does not inherently describes a slurry that removes tungsten at substantially the same rate or at a slower rate than copper is removed, as required in amended claim 1. These arguments are unpersuasive for the following reasons: It is noted that the instant claimed invention, as recited in claim 1, drawn to a composition/product and the recitation of "formulated to substantially concurrently polish copper and a barrier material comprising tungsten with the tungsten being removed at substantially the same

rate as or at a slower rate than copper is removed" is considered as intended use of the claimed composition/function of the claimed composition. It is also noted that composition claim covers what the composition is not what the composition does and "Likewise the intended use of composition is not patentably significant. In re Albertson 141 USPQ 730 (CCPA 1964); In re Heck 114 USPQ 161 (CCPA 1957)". "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." Atlas Powder Co. v. Ireco Inc., 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). >In In re Crish, 393 F.3d 1253, 1258, 73 USPQ2d 1364, 1368 (Fed. Cir. 2004), the court held that the claimed promoter sequence obtained by sequencing a prior art plasmid that was not previously sequenced was anticipated by the. In this case since Hudson's slurry being substantially free of abrasive and comprises components of: ferric nitrate/oxidizer and benzotriazole/inhibitor which meets the requirement of claimed composition, it is also noted that Section 2112.01 [R-3] of the MPEP also states : "Composition, Product, and Apparatus Claims

I. PRODUCT AND APPARATUS CLAIMS -- WHEN THE STRUCTURE RECITED IN THE REFERENCE IS SUBSTANTIALLY IDENTICAL TO THAT OF THE CLAIMS, CLAIMED PROPERTIES OR FUNCTIONS ARE PRESUMED TO BE INHERENT

Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)". Therefore it is maintained that Hudson anticipates the claimed invention as recited in claim 1

Applicants further argue Hudson teaches away from dissolving conductive material while oxidizing and polishing the same (col. 4, lines 1-19 and col. 5, lines 55-64). In contrast, Nakazato teaches a chemical dissolving solution having a good dissolving capacity for various kinds of metals (col. 2, lines 33- 35), which is insufficient to overcome the fact that Hudson teaches away from the asserted combination. Hence, one would not be motivated to combine these references. This argument has been considered but are unpersuasive because the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, since the motivation to combine Hudson and Nakazato comes from Nakazato, one skilled in the art at the time the invention was made would have found it

obvious to have employed Nakazato teaching in Hudson method to produced the claimed inventions. Therefore the rejection(s) of claims 12-14, 21-25 under U.S.C 103(a) are maintained in this office action

### ***Claim Objections***

2. Claim 29 objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The limitation of claim 29 is already required in claim 28

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-8, 10-13, 15-19, 23-25, 26-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Hudson (US 5,972,792).  
Hudson teaches a method of chemical-mechanical planarization of a substrate on a fixed abrasive polishing pad in which a planarizing solution (free of abrasive) is

dispensed onto the pad. The planarizing solution comprises components including an oxidant (0.5-5.0%) such as nitric acid and 0.1%-10%, benzotriazole/inhibitor (column 4, lines 35-37 and 53-56); the planarizing solution has a pH of 3.0-10.00 (col 4, lines 53-55). It is noted that claim 1 drawn to a composition. The recitations of "formulated to substantially concurrently polish copper and a barrier material comprising tungsten with the barrier material tungsten being removed at substantially the same rate as or at a slower rate than copper is removed", "for use with a fixed-abrasive polishing pad comprising at least one of aluminum dioxide, titanium dioxide, silicon dioxide, and cerium dioxide", "formulated to oxidize copper at substantially the same rate as or at a faster rate than the barrier material is oxidized", "the barrier material and copper have substantially the same oxidation energies", "the barrier material has an oxidation energy of about 0.25 V more to about 0.20 V less than an oxidation energy of copper", "a rate of removal of the barrier material is up to about ten times slower than a rate of removal of copper.", "a rate of removal of the barrier material is about two to about four times slower than a rate of removal of copper", "formulated to remove copper and the barrier material without substantially dissolving the barrier material that underlies remaining portions of copper" and "formulated to remove copper at a temperature of about 27 degree C, or cooler" are considered to be intended use/functional languages that do not patentably distinguish the claimed inventions from the prior art because "Likewise the intended use of composition is not patentably significant. In re Albertson 141 USPQ 730 (CCPA 1964); In re Heck 114 USPQ 161 (CCPA 1957)".

The limitations of claims 10-13, 15-19, 23-24 have been discussed above

Regarding claims 26-27, 28, Hudson discloses that the solution comprises potassium iodate/oxidizer, the planarizing solution comprises components including an oxidant (0.5-5.0%) and 0.1%-10% of benzotriazol (column 4, lines 35-37 and 53-56 , ammonium hydroxide/ complexing agent, BTA (col 4, lines 35-65). It is noted that the recitation of "an oxidation energy of tungsten in the slurry being within an inclusive range of 0.25 V more than an oxidation energy of copper in the slurry to 0.20 V less than the oxidation energy of copper in the slurry" is considered as a physical property of the claimed slurry. However, it is noted section 2112.01 of the MPEP states: "II.

COMPOSITION CLAIMS -IF THE COMPOSITION IS PHYSICALLY THE SAME, IT MUST HAVE THE SAME PROPERTIES "Products of identical chemical composition can not have mutually exclusive properties." A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)".

#### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudson (US '792) as applied to claim 1 above, and further in view of Nakazato et al. (US 4,459,216).

Hudson differs in failing to teach at least one pH control agent as recited in claims 9, 14

Nakazato teaches a chemical dissolving solution that is used in chemical polishing of metals such as copper. The chemical dissolving solution comprises hydrogen peroxide, an inorganic acid such as sulfuric, phosphoric (pH control agents) and nitric acid and an aromatic compound (Abstract; column 1, lines 5-15 and 28-33; and column 3, lines 12-24). The chemical dissolving solution includes 5g/l- 100 g/l (-0.1 to 10 %) of hydrogen and 100 g/l - 300 g/l of inorganic acid for polishing copper (column 3, lines 34-41 ). Nakazato also discloses a reference, which teaches a chemical polishing solution for copper, which comprises 0.5- 30 % (w/w) sulfuric acid, 5-60% (w/w) hydrogen peroxide, and at least 0.1% (w/w) of an amine such as benzotriazole is used (column 1, lines 43-52).

Since the Nakazato reference is relied upon to teach an abrasive free solution comprising the specific concentration of oxidizer and pH control agent, then it would have been obvious to one having ordinary skill in the art at the time of the claimed invention to modify Hudson solution to include a pH control agent as per Nakazato for the purpose of providing a chemical dissolving solution having good stability, a long life, and capability of producing a lustrous metal surface for use in chemical polishing (column 1, lines 5-6 and column 2, lines 33-37)

5. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudson (US '792) as applied to claim 1 above, and further in view of Suzuki et al. (US 5,885,334).

Hudson differs in failing to teach at least one complexing agent comprising at least one of glycine, ammonium citrate, ammonium phosphate, and ammonium acetate.

Suzuki teaches a polishing composition, which does not contain abrasive particles (column 6, lines 12-14). Suzuki also teaches the addition of a chelator and other additives (10%) (col 8, lines 30-32) such as glycine (same as applicants' complexing agent) can be added to the composition in order to give the composition additional properties. The addition of a chelator to the polishing composition is effective since metallic residue adhering to the polishing surface can be reduced (column 7, lines 14-28).

Since Suzuki illustrates a complexing agent is known, then it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Hudson by employing a chelator (same as applicants' complexing agent) as taught in the Suzuki reference for the purpose of reducing metallic residue adhering to the polishing surface (Suzuki, column 7, lines 23-26).

**6. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### ***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to LAN VINH whose telephone number is (571)272-1471. The examiner can normally be reached on M-F 8:30-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nadine Norton can be reached on 571 272 1465. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lan Vinh/  
Primary Examiner, Art Unit 1792